



41

1647-

PTO/SB/21 (01-03)

Approval for use through 04/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/898,456
		Filing Date	Jul 3, 2001
		First Named Inventor	Friddle, Carl Johan
		Art Unit	1647
		Examiner Name	R. Hayes
Total Number of Pages in This Submission	7	Attorney Docket Number	LEX-0198-USA

ENCLOSURES <i>(check all that apply)</i>		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to Group (<i>Appeal Notice, Brief, Reply Brief</i>)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i>
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> - Return Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

Customer # 24231

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual	Lexicon Genetics Incorporated	
	Lance K. Ishimoto	Reg. No. 41,866
Signature	<i>Lance K. Ishimoto by David W. Hobart</i> DAVID W. HOBART REG. NO. 44,071	
Date	November 3, 2003	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: USPTO, PO Box 1450, Alexandria, VA 22313-1450 on this date:		
		November 3, 2003
Typed or printed	Michelle Klein	
Signature	<i>Michelle Klein</i>	Date November 3, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
TECH CENTER 1600/2900
NOV 17 2003

Applicant(s):	Friddle <i>et al.</i>	Group Art Unit:	1647
Application No.:	09/898,456	Examiner:	R. Hayes
Filed:	07/03/2001	Atty. Docket No.: LEX-0198-USA	
Title: Novel Human Secreted Signal Proteins and Polynucleotides Encoding the Same			

AMENDMENT AND RESPONSE TO RESTRICTION REQUIREMENT
DATED OCTOBER 1, 2003

Commissioner for Patents
Alexandria, VA 22313

Sir:

The Examiner is respectfully requested to enter the following amendments. A response to the Restriction Requirement dated October 1, 2003 (hereafter "the Requirement") is also included herewith, and the Examiner is respectfully requested to consider the remarks therein.

The response is due on November 1, 2003, which falls on a Saturday and is therefore extended until Monday, November 3, 2003 under 37 C.F.R. § 1.7. The response is thus timely filed, and Applicants believe no fees are due in connection with this response. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0892.

AMENDMENT

In the claims:

Please cancel claims 2–4, 7 and 8, entirely without prejudice and without disclaimer, as drawn to non-elected inventions.

Please cancel claim 6 without prejudice and without disclaimer.

Please amend the claims as follows:

1. (Currently Amended) An isolated nucleic acid molecule comprising ~~at least 24 contiguous bases of a nucleotide sequence encoding an~~ the amino acid sequence ~~drawn from the group consisting of SEQ ID NOS: 2, 4, 7, 9, 11, 13, 15, 17, 19, 21 and 23 of SEQ ID NO: 7.~~

2. (Cancelled)

3. (Cancelled)

4. (Cancelled)

5. (Currently Amended) An isolated nucleic acid molecule comprising ~~at least 24 contiguous bases of the nucleotide sequence first disclosed in~~ of SEQ ID NO: 6.

6. (Cancelled)

7. (Cancelled)

8. (Cancelled)

9. (New) A recombinant expression vector comprising a nucleic acid molecule that encodes the amino acid sequence of SEQ ID NO:7.

10. (New) The recombinant expression vector of claim 9, wherein said nucleic acid molecule

comprises the nucleotide sequence of SEQ ID NO:6.

11. (New) A host cell comprising the recombinant expression vector of claim 9.

RESPONSE

I. Restriction Requirement

The Examiner has determined that the original claims are directed to eleven separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1 (in part), 2 and 3, said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:1, or encoding the polypeptide of SEQ ID NO:2, classified in class 536, subclass 23.1;
- Group II: Claims 1 (in part) and 4, said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:3, or encoding the polypeptide of SEQ ID NO:4, classified in class 536, subclass 23.1;
- Group III: Claims 1 (in part), 5 and 6, said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:6, or encoding the polypeptide of SEQ ID NO:7, classified in class 536, subclass 23.1;
- Group IV: Claims 1 (in part) and 7, said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:18, classified in class 536, subclass 23.1;
- Group V: Claims 1 (in part) and 8, said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:8, classified in class 536, subclass 23.1;
- Group VI: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:11, classified in class 536, subclass 23.1;
- Group VII: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:13, classified in class 536, subclass 23.1;
- Group VIII: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:15, classified in class 536, subclass 23.1;
- Group IX: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:17, classified in class 536, subclass 23.1;
- Group X: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:21, classified in class 536, subclass 23.1; and
- Group XI: Claim 1 (in part), said to be drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:23, classified in class 536, subclass 23.1.

II. Response to Restriction Requirement

In response to the Restriction Requirement, Applicants hereby elect without traverse to prosecute the claims of the Group III invention (claims 1 (in part), 5 and 6), drawn to isolated nucleic acid molecules corresponding to SEQ ID NO:6, or encoding the polypeptide of SEQ ID NO:7, classified in class 536, subclass 23.1. Accordingly, claims 2-4, 7 and 8 have been cancelled herein without prejudice and without disclaimer, as drawn to non-elected inventions.

Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

III. Status of the Claims

Claims 2-4, 7 and 8 have been cancelled without prejudice and without disclaimer as being drawn to non-elected inventions. Claim 6 has been cancelled without prejudice and without disclaimer. Claims 1 and 5 have been amended. New claims 9-11 have been added.

Claims 1, 5 and 9-11 are therefore presently pending in the case.

IV. Support for the Amended and Newly Added Claims

Claim 1 has been revised to further improve its clarity, to reflect the election set forth in Section II above, and to specifically recite an isolated nucleic acid molecule comprising a nucleotide sequence encoding the amino acid sequence of SEQ ID NO:7. Support for this claim can be found throughout the specification and claims as originally filed, with particular support being found in original Claim 1.

Claim 5 has been revised to further improve its clarity, and to specifically recite an isolated nucleic acid molecule comprising the nucleotide sequence of SEQ ID NO:6. Support for this claim can be found throughout the specification and claims as originally filed, with particular support being found in original Claim 5.

Claims 9 and 10 have been added to specifically recite recombinant expression vectors comprising nucleic acid molecules of the present invention. Support for these claims can be found throughout the specification as originally filed, with particular support being found at least from page 13, line 30 to page 14, line 3.

Claim 11 has been added to specifically recite host cells comprising the recombinant expression vectors of claim 9. Support for this claim can be found throughout the specification as

originally filed, with particular support being found at least at page 14, lines 3-9.

It will be understood that no new matter is included within the amended or newly added claims.

V. Inventorship

In response to the Examiner's reminder that, upon election of claims in response to the Restriction Requirement, inventorship must be amended in compliance with 37 C.F.R. § 1.48(b), Applicants respectfully request amendment of the inventorship of the present application under 37 C.F.R. § 1.48(b)(1) in order to remove an inventor of the non-elected invention, since her invention is no longer being claimed in the present application as amended. The inventor *that is requested to be removed* as a result of the cancellation of the non-elected claims as a result of the response to the Restriction Requirement is Erin Aylor. The inventors of the remaining claims are, therefore, Carl Johan Friddle, John Scoville and D. Wade Walke.

As set forth under 37 C.F.R. § 1.48(b)(2), the Commissioner is hereby authorized to charge the fee required under 37 C.F.R. § 1.17(i) for this amendment and request to correct inventorship to Deposit Account No. 50-0892.

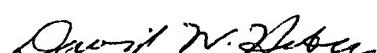
VI. Conclusion

The present document is a complete response to the Restriction Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Hayes have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

November 3, 2003

Date



David W. Hibler

Reg. No. 41,071

Agent for Applicants

LEXICON GENETICS INCORPORATED
8800 Technology Forest Place
The Woodlands, TX 77381
(281) 863-3399